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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/716,391 11/20/00 HOYT

D 1600/19

EXAMINER

QM32/1019

BANIAK FINE & GANNON  
150 N WACKER DR.  
SUITE 1200  
CHICAGO IL 60606

LAYNO, B

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

10/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/716,391

Applicant(s)

HOYT ET AL

Examiner

Benjamin H. Layno

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Double Patenting***

1. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,149,155. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the present application recites several limitations that are similar to the limitations in claim 1 of the patent, except that claim 1 of the present application recites limitation of "104 cards" while the claim 1 of the patent does not. Furthermore, claim 1 of the present application is broader than claim 1 of the patent because claim 1 of the present application does not recite the limitation "two cards of said deck contain the same quantity and suit and such that a first playing card may be placed either on a playing game board or some other location adjacent to a second playing cards combining to form a standard playing card, but approximating twice the size of said first or second playing card" recited in claim 1 of the patent. Furthermore, claim 12 of the present application recites several limitations that are similar to the limitation of claim 11 of the patent, except that claim 12 of the present application recites the limitation "104 cards" while claim 11 of the patent does not.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8-14, 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown.

The patent to Brown discloses a plurality of playing cards 12 divided into two decks. Each deck has fifty-two playing cards, see column 1, lines 5-14. Thus, there are a total of 104 playing cards. The back sides of each card may contain similar designs such that the back sides are all identical, see column 2, lines 41-43. The front side of each card contains a location indicia 11 illustrating a portion of an animal. The illustrations are located at a certain corner of each card. On card 21, which is the top left card in Fig. 1, the location indicia 11 is located on the bottom right corner, thus indicating that the card 21 is located on the top left. The front side of each card also has a quantity indicia 33 which is a number between at least two and ten, and a suit

indicia 41-44 which is spade, heart, diamond, or club. When four playing cards, (which is at least two playing cards), are placed adjacent to each other, the four playing cards form an illustration of a complete playing card four times, (which is at least twice), the size of a playing card.

In regard to the limitation "said playing card in a standard deck of playing cards" in claim 1, The only difference between indicia illustrating Brown's complete playing card, Fig. 1, and indicia on the claimed playing card in a standard deck of playing cards, resides in the meaning and information conveyed by printed matter, and such differences are unpatentable, *Ex parte Breslow*, 192 USPQ 431.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown as applied to claims 5 and 13 above, and further in view of standard deck of playing cards.

Brown's playing cards clearly has quantity indicia and suit indicia which are similar quantity indicia and suit indicia of a standard deck of playing cards. In view of

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such teaching, it would have been obvious to modify Brown's cards having numerals "1", "11", "12" and "13" by substituting for these numerals the illustrations representing Ace, Jack, Queen and King, respectively. This modification would have made Brown's playing cards more similar to a standard deck of playing cards in order to attract card players.

***Claim Rejections - 35 USC § 112***

3. Claims 1, 2, 10, 12 recite the limitation "the approximately 104 cards". There is insufficient antecedent basis for this limitation in the claims.

4. Furthermore, claims 2 and 12 recite the limitation "said standard deck of playing cards" on the last line of these claims. There is insufficient antecedent basis for this limitation in the claims.

***Claim Objections***

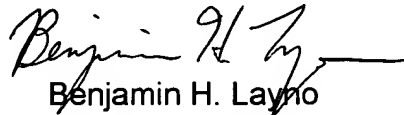
5. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 10 recites "said number of individual playing cards approximates 104 playing cards. This limitation is already recited in claim 1.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (703) 308-1815. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman can be reached on (703) 308-1310. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl  
October 16, 2001